

REMARKS

In reply to the Office Action dated January 30, 2004, Applicant has added an Abstract of the invention, cancelled claims 1, 2-5, 7-16, 18, and 19, without prejudice or disclaimer of the subject matter therein, amended claims 20-25 to clarify the claimed invention, added new claims 26-46 to protect additional aspects of the invention. As a result of this Amendment, claims 2, 6, 17, and 20-46 are currently pending.

On pages 2-3 of the Office Action, the Examiner rejected claims 20-25 under 35 U.S.C. § 112, second paragraph, based on indefiniteness grounds. In response, Applicant has amended claims 20-25, as specifically suggested by the Examiner. Accordingly, each of the claims fully comply with 35 U.S.C. § 112, second paragraph.

As discussed on pages 3-4 of the Office Action, the Examiner rejected claims 2, 6, and 17 under 35 U.S.C. § 102(e) as being anticipated by Odom et al. (U.S. Patent No. 6,058,379). Moreover, the Examiner rejected claims 20-25 under 35 U.S.C. § 103(a) as being unpatentable over Odom et al., according to the rationale discussed on page 5 of the Office Action.

Odom et al., however, fails to render the claimed invention unpatentable. Each of the claims recite different combinations of features that distinguish the invention from the prior art. For example, independent claim 2 recites a combination that includes, among other things,

inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service; [and]
randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time,

(claim 2, ll. 8-18). Independent claim 6 recites another combination that includes, for example,

displaying, on the web site, a sale offer of a product or service to the at least one selected buyer at a random point in time unknown to the buyer; and withdrawing the displayed sale offer from the Internet website when the at least one buyer does not indicate acceptance of the sale offer within a predetermined period of time,

(claim 6, p. 3, l. 22 - p.4, l. 5). Independent claim 34 recites yet another combination that includes, *inter alia*,

randomly displaying at least one offer to accept a product or service to a selected recipient connected to the electronic network system at an unknown start time,

(claim 34, ll. 5-18. Finally, independent claim 42 recites a combination of that includes, for instance,

providing a random frequency device for randomly displaying an offer to a selected recipient on the electronic network system to accept a discounted product or service at a price substantially equal to the delivery price of the product or service, the randomly displayed offer having an unpredictable start time and the selected recipient being selected from a plurality of potential recipients,

(new claim 42, ll. 5-22). At the very least, Odom et al. fails to disclose or suggest any of these exemplary features recited in the independent claims.

To establish anticipation under 35 U.S.C. § 102(e), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Odom et al. patent. See M.P.E.P. § 2131 (7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). Moreover, to make out a *prima facie* case of obviousness, the Examiner must demonstrate (1) that Odom et al., as proposed to be modified by the Examiner, discloses or suggests each and every feature recited in the claim, (2) that there is a reasonable probability of success of such modifications, and (3) the existence

of some suggestion or motivation, either in the Odom et al. patent itself or in the knowledge generally available to one of ordinary skill in the art, to make such modification so as to result in the claimed invention. See M.P.E.P. § 2143 (7th ed. 1998). It bears emphasizing that each of these requirements must be found in the prior art — not based on Applicant's own disclosure. See *id.*

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Odom et al., taken alone or in combination with any other prior art reference, can either anticipate or render obvious each and every one of the limitations present in the independent claims, as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Odom et al. discloses a real-time network exchange with seller specified exchange parameters and interactive seller participation. See Abstract. Odom et al., however, fails to provide any disclosure whatsoever of either "inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service," or "randomly displaying, through the electronic network system, the at least one sale offer to a selected buyer at an unexpected period of time," as stated in

independent claim 2. Similarly, Odom et al. fails to provide any disclosure of the random display features recited in independent claims 6, 34, and 42. Instead, Odom et al. teaches away from the claimed invention by necessarily specifying the start time for a sale offer on an electronic exchange between a seller and a potential buyer. For instance, Odom et al. specifically discloses a system that

enables the capability to operate an exchange that is based on at least an eight-step capability. In step one, the mode of operation of the exchange is specified. In this step, parameters such as the start/stop time for the exchange, the exchange's open or closed status, public or private access to negotiations, seller information, bid requirements, etc. may be specified. This may be done by the seller and/or auction host. Next, the proposed exchange item can be further identified. This information may include entering information about the item to be sold, which may include its classification, pricing information, etc. Next, the proposed item is added to an electronic listing. This may include posting the information on a world wide web page,

Col. 3, ll. 13-26 (emphasis added). By contrast, independent claims 2, 6, 34, and 42 call for an offer for sale on an electronic network system that is random, or, by definition, unpredictable. These features are neither explicitly stated, nor necessarily present within the Odom et al. patent disclosure, as required by 35 U.S.C. § 102. Accordingly, Odom et al. cannot anticipate independent claims 2, 6, 34, and 42.

For at least these reasons, Odom et al. fails to disclose or render obvious each and every element recited in the independent claims. In addition, claims 17, 20-33, 35-41, and 43-46, which all depend upon one of the independent claims, respectively, recite additional features that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims are allowable for at least the same reasons discussed above with respect to the independent claims 2, 6, 34, and 42.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all the pending claims 2, 6, 17, and 20-46. Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's representative at (202) 408-6052.

Please grant any extension of time to the extent required to enter this response and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.**

By: 

Christopher W. Day
Registration No. 43,944

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Attachments: Appendix A: Abstract